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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/623,316	08/31/2000	Roger George Buck	36-1363	1857

7590 04/30/2004

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EXAMINER

LE, HIEU C

ART UNIT	PAPER NUMBER
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2142

DATE MAILED: 04/30/2004

8

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/623,316

Applicant(s)

BUCK ET AL.

Examiner

Hieu c. Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,6-9,12,13 and 15-18 is/are rejected.
- 7) ☒ Claim(s) 3-5,10-11,14 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

1. The amendment filed 2/20/04 has been entered and made record.
2. In response to amendment filed the 112,2nd paragraph is withdrawn.
3. Applicant's argument filed 2/20/04 have been fully considered but they not persuasive for following reasons:

Applicant alleges that " the applicant invention deals with [,]", (p. 9, line 11- p. 10, line 20). The Examiner disagrees. Firstly, the Applicant is respectfully reminded that claim(s) 1,8-9 are independent claims and the feature upon which Applicant relies the (terminal being external) is not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. *In re Van Guens*, 988 F. 2d 1181, 26 USPQ2d 1057 (Fed. Cir 1993). Secondly, Ram '924 reads on the claims as broadly claimed.

4. The amendment filed 2/20/04 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: "at least the remainder of the entire set of execute code, (i.e. at least the portions of the set not already stored as a subset in terminals) in the amended paragraph beginning at Page 5, line 19.

Applicant is required to cancel the new matter in the reply to this Office Action.

5. Claim 8 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession

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of the claimed invention. Claim 8 recites "within the set but not within the subset earlier stored at the first terminal". There is no disclosure of "within the set but not within the subset earlier stored at the first terminal" in the specification as originally filed nor how to perform it.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-2,6-9, 12-13,16-17,19 rejected under 35 U.S.C. 102(e) as anticipated by Ram et al [U.S. Pat. No. 6, 028,924] .

As to claim 1, Ram discloses a method of communications employing a predetermined communications protocol defining respective responses to predetermined events, the method comprising:

separating said protocols into a first group of responses to corresponding first events, and a second group of responses to corresponding second events, wherein said first events occur frequently relative to said second events [the calling protocols is to calls that do not require additional call processing capability and functions (frequently occurred) and calls that requires additional enhanced service (col. 5, lines 12-16, lines 46-50];

storing said first group at a communications user terminal [(Fig. 4. trigger database 102 stores the first group on the switch node 24 (terminal)), storing at least the second group at a store remote from said user terminal, and interconnected therewith via a communications channel [Fig. 4. second group is stored on SCU 34 connected with link 40 to the switch node 24 (terminal)];

communicating from said user terminal using said first group of responses (col. 9, line 55-col. 10, line 11);

on detecting an event other than one of said first events at said user terminal, signalling event-handling data from said store to said user terminal (col. 9, line 63-col. 10, line 11); and

communicating from said user terminal using said event-handling data (col. 10, lines 14-22).

As to claim 2, Ram further discloses when the detected event is of the group of second events, said event-handling data comprises at least the responses of said second group which correspond thereto (col. 9, line 63-col. 10, line 11, col. 11, lines 11-35); and

As to claim 6, Ram further discloses in which said event-handling data comprises data defining instructions for handling the detected event (col. 47, line 36-67);

As to claim 7, Ram further discloses a method according to, wherein the protocol is for use of an ISDN communications channel (col. 4, line 47).

As to claim 8, [as best understood by the Examiner] Ram discloses a communications system (Fig. 1, switch node 24) comprising;

a first terminal (Fig. 1, item 24).

a second terminal interconnect able with the first via a telecommunications network [Fig. 1, item SCU 34 (second node) connected via link 40]; and
a store connected to said network (Fig. 1, item 56).

in which:

the second terminal is arranged to communicate using a communications protocol defining a set of responses to respective conditions (col. 12, item 10-35).

the first terminal is arranged to store, and communicate using, a subset of the protocol (col. 9, line 63-col. 10, line 11); and

the store is arranged to cooperate with the first terminal for handling conditions requiring a response within the set but not within the subset earlier stored at the first terminal (col. 42, line 36-col. 43, line 5).

As to claim 9, Ram discloses communications terminal for use with a communications protocols defining a set of responses to respective predetermined events said terminal, comprising;

a communications port for connection to a communications channel (col. 4, line 55-59 & col. 6, lines 7-13).

a signalling port for connection to a signalling channel (col. 16, lines 5-17); and

a store for storing data defining a core subset of said response

corresponding to a core subset of said events (col. 9, line 63-col. 10, line 11; and

a controller for controlling communications via the communications and signalling ports in accordance with said core subset (col. 42; lines 36-67).

the terminal being arranged to detect events not within said core subset, and to receive event-handling data via said signalling port (col. 16, lines 5-36), and controller being arranged to handle said detected events in accordance with said received event-handling data (col. 17, lines 35-38).

As to claim 12, Ram further discloses the controller is arranged to accept said event-handling data as one or more communications signalling instructions for immediate execution (col. 42, lines 36-58).

As to claim 13, Ram further discloses the terminal being arranged to signal said detected events via said signalling port and to receive said event-handling data in response thereto (col. 16, lines 16-21).

As to claim 15, Ram further discloses wherein said store does not comprise a movable magnetic storage medium (col. 7, line 19).

As to claim 16, Ram further discloses which lacks a movable magnetic storage Medium (col. 7, line 19).

As to claim 17, Ram further discloses which comprises a network client Terminal (Fig. 5, item 113).

Claim Rejections - 35 U.S.C. § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ram et al [U.S. Pat. No. 6, 028,924].

As to claim 18, Ram discloses the invention substantially as claim discussed above. Ram does not explicitly disclose a video output port for co-operation with a television set.

However, Ram further discloses a video display port to connect to a video display terminal (col. 7, line 19). The use of a television set to display video is obvious in view of video display etc.

Allowable Subject Matter

10. Claims 3-5, 10-11, 14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 11 depends claim 10 (include claim 10).

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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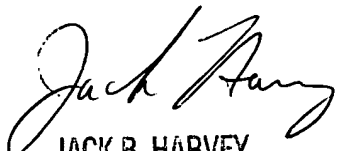
the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hieu Le whose telephone number is (703) 306-3101. The examiner can normally be reached on Monday to Friday from 7:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley, can be reached on (703) 308-5221. The fax phone number for this Group is (703) 308-5357.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Hieu Le


JACK B. HARVEY
SUPERVISORY PATENT EXAMINER